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SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

In re Application of BIRNBAUM et al :
U.S. Application No.: 10/564,638 :
PCT Application No.: PCT/US2004/018933 :
Int. Filing Date: 15 July 2004 : DECISION
Priority Date Claimed: 15 July 2003 :
Attorney Docket No.: A8563 :
For: SOCIAL NETWORK OR IDENTITIES AND :
QUERY METHOD THEREFOR :

This is in response to applicant's "Petition Under 37 C.F.R. § 1.47(a)" filed 05 December 2006.

BACKGROUND

On 15 July 2004, applicant filed international application PCT/US2004/018933, which claimed priority of an earlier United States application filed 15 July 2003. The thirty-month period for paying the basic national fee in the United States expired on 15 January 2006.

On 12 January 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 05 May 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 05 December 2006, applicant filed the present petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be

reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, the declarations filed with the petition are improper because they fail to state the citizenship of the second inventor as required by 35 U.S.C. 115 and 37 CFR 1.497(a)(3).

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

The petition states that joint inventor Adarbad Master cannot be located after diligent effort. Petitioner has supplied the affidavit of Nigel Simmons, the person with apparent firsthand knowledge of efforts made to locate Master. Simmons' affidavit indicates that although he was at one time in contact with Master, Master can no longer be reached. Master has failed to respond to repeated electronic mail messages. Furthermore, although application papers mailed to Master on 28 November 2006 were delivered to the Master's last known address, the tracking data indicates that the correspondence was accepted by someone other than Master. However, the petition does not establish that applicant tried any additional methods to locate Master, i.e. by telephone, by consulting Master's former co-workers, by attempting to obtain a forwarding address, or by searching public directories. Thus, it would not be reasonable to conclude at the present time that Master cannot be found after diligent effort.

With regard to item (3) above, applicant is advised that effective 22 November 2004, the fee for a petition under 37 CFR 1.47 increased to \$200.00. Any deficiency in the petition fee will be charged to Deposit Account No. 19-4880 as authorized in the petition.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely file a proper response will result in abandonment of

the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

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